

In the United States
Circuit Court of Appeals
For the Ninth Circuit

LOUIE J. ANTONSEN,

Plaintiff-Appellant,

vs.

C. C. HEDRICK, individually, and doing business
under the assumed name and style of PAPER
EXCELSIOR & PAD COMPANY,

Defendant-Appellee,

Brief of Defendant-Appellee

Upon Appeal from the District Court of the United
States for the District of Oregon.

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SEP 25 1935

PAUL R. GERRARD



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Note: All references to Hopkins are to the 1911 edition.

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STATEMENT OF FACTS

In his Bill of Complaint the appellant claims that the appellee has infringed one or all of Claims 1, 2 and 7 of the involved patent.

After certain denials, appellee in his answer, specifically pleads various of the statutory defenses:

First: That the appellant was not the original and first inventor or discoverer of any material and substantial part of the thing patented;

Second: That he surreptitiously or unjustly obtained the patent or that it was in fact invented by another;

Third: That it had been described in some printed publication prior to his supposed invention or discovery thereof for more than two years prior to his application for a patent therefor; and,

Fourth: That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

Upon issues joined trial was had.

These facts admit of no dispute in the record: One Claude C. Rafter, on and prior to 1923, lived in Seattle, Washington. So did appellant, Antonsen. In the summer of 1923 Rafter conceived of and built a machine for the purpose of making paper excelsior. His first successful machine was built and operated with applied power in August, 1923. He manufactured paper excelsior and sold it to the public in Seattle at that time and had a ready market for all he could produce. (See Testmony of Appellant's witness, Wright R 335.) The machine and the

produced paper excelsior attracted wide attention; they appeared new and novel and trade was immediately developed with various users of excelsior. This paper excelsior was new to the trade. The machine was relatively very simple and inexpensive to build, costing about \$100.00. A woman by the name of Mrs. Wright worked part time for Mr. Rafter feeding newspaper stock into the machine and Antonsen was then, and more or less continuously to the date hereof, has employed one or more of the sons of Mrs. Wright. Through this source Antonsen learned of the Rafter machine and product as early as January, 1924. Antonsen was impressed with the commercial significance of this machine and its product. In a surprisingly short time Rafter sold seven of these machines to the following parties:

1. Calhoun, with whom Thomas E. Henderson was associated, which sale was made approximately February 1, 1924.

2. Greenwood and Carlson for Chicago, Illinois. This machine was sold in approximately March, 1924.

3. To C. A. Wheeler, then of Seattle, Washington, which machine was sold about March, 1924. As will be shown, Wheeler shortly thereafter took this machine to Portland, Oregon, operated it here, sold it to Hedrick, appellee, and this machine and its product is the machine and the product which appellant now claims infringes the involved patent which was not even ap-

plied for until August 30, 1926, or well over two years thereafter.

4. A sale was made to one Thompson for Kansas City.

5. A machine was sold to Rowden.

6. A machine was sold to E. L. Foster, then of Seattle, Washington, around March 17, 1924.

7. The machine actually operated by Rafter in Seattle was sold to the appellant, who took possession on June 1st, 1924. Antonsen paid for this machine and Rafter's business and a few miscellaneous items of personal property of insignificant value, approximately \$2900.00. Admittedly Antonsen operated this machine "as was" until late in the year of 1925, when he claims to have made it over into a "tearing" machine.

The Rafter machine unquestionably severed newspaper stock into narrow strips, separated the same more or less and discharged and cascaded them to the floor in a haphazard fashion. The Rafter machine combined a pair of parallel and oppositely rotated spindles, each mounting a plurality of intermeshing beveled edged discs. The lower spindle was fixedly mounted. The upper spindle was not fixedly mounted, but had a coil spring which admitted of movement. The coil spring tended to force the upper spindle to a pre-determined position, and also permitted separation from the pre-determined

point when the machine was operated under load. Of course, Rafter had conveying means to convey the paper stock between the intermeshing discs.

However, there is dispute and controversy on three (3) factual questions:

First: Did the Rafter machine from 1923 on down to the present time produce torn excelsior?

Second: Was the Rafter machine adjusted so that the intermeshing discs were separated; and,

Third: If the intermeshing discs were in facial contact, was it an inherent quality and attribute of the machine that under load a separation would take place between the contiguous intermeshing disc?

Appellee contends the machine produced torn paper excelsior; that the discs were intentionally adjusted so as not to be in facial contact and that if they were in facial contact they would necessarily be removed from contact in the course of normal operation. The appellant contends to the contrary. The trial court found in keeping with the contention of appellee. (See Findings of trial court No. V, R-48-49.) The trial court based its findings upon evidence found by it,—” * * * clear, unequivocal and convincing and establishes each and all of such facts to the complete satisfaction of the court fully and completely” (R-52). We now review the evidence on these points.

REVIEW OF EVIDENCE SUPPORTING FINDING THAT RAFTER MACHINE PRODUCED TORN EXCELSIOR.

1. Testimony of Witnesses:

The following witnesses testified that the Rafter machine produced rough-edged, feather-edged and scalloped-edged excelsior:

G. H. THOMPSON.

Thompson was a resident of Seattle and in business there in 1923. In the middle or latter part of that year he purchased paper excelsior from Rafter.

He testified:

“The edges of the first excelsior bought from Rafter were irregular and rough, it was shredded—I don’t know any other way to describe it.”

He identified defendant’s Exhibit No. 2 as being similar to the kind of excelsior used at the beginning (R-297).

THOMAS E. HENDERSON.

This witness lived in Seattle, visited Rafter’s place of business as early as September or October, 1923, purchased one of the machines in connection with Calhoun. He testified it had a torn or feather edge (R-299). He also identified the first excelsior as just like defendant’s Exhibit 2.

B. T. RAND.

Mr. Rand lived in Seattle in 1923, was engaged in

the real estate business, with his place of business near to Mr. Rafter's plant. He saw the machine in operation in 1923. He testified the majority of the excelsior seemed to have a feather edge on it,—a scalloped appearance,—what I would call a feather edge, and that defendant's Exhibit No. 2 was similar to the excelsior he saw in 1923. He stated it was about the same excelsior (R-303-304).

R. M. BENSON.

Mr. Benson lived in Seattle, was employed by Seattle Hardware Company as Superintendent. Mr. Rafter was the first man that ever sold paper excelsior to the company. He stated he never noticed any difference in the texture of the outer edges between the first excelsior bought and that purchased at any subsequent time (R-307).

WILLIAM D. RAINWATER.

Mr. Rainwater lived in Seattle in 1923 and was engaged in the novelty business and purchased excelsior from Rafter as early as 1923 or 1924. He never noticed any difference between the first excelsior he used and the present day excelsior (R-315).

CHARLES W. PALMER.

This witness resided in Seattle and was superintendent of the warehouse of the National Grocery Company continuously since 1923. He, or his firm, had never heard of paper excelsior before. He remembered the interview with Rafter very clearly

and remembered that he had invented a machine for shredding paper. As best he can recall the strips were shredded and not cut. The excelsior was very adaptable for packing purposes,—its use was successful and more satisfactory than wood excelsior and has been continuously used (R-316).

CLAUDE E. RAFTER.

This witness is a son of Mr. Rafter. As mentioned, Antonsen took delivery of Rafter's machine in June, 1924, and thereafter, for a number of months this witness was associated with Antonsen and actually operated the machine. He testified that from the time power was applied, his father's machine produced a rough, feather edged and scalloped edged excelsior. He also pointed out that these characteristics would be accentuated by thicker feedings of newspaper stock. The witness was familiar with the paper excelsior produced by Antonsen's allegedly invented "tearing machine," and stated that there was no difference between that excelsior and the excelsior first produced by his father (R-305-306).

LEONARD E. SIMPSON.

This witness lived in Seattle in 1923 and 1924. In 1924 he was manager of a district for the Seattle Times. After Claude E. Rafter severed his relations with Antonsen, this witness worked for Antonsen making paper excelsior with the machine Antonsen had purchased from Rafter. He testified that the excelsior, as he observed it, was rough (R-308).

C. C. RAFTER.

This witness testified that the first and all paper excelsior manufactured with the use of his machines, had rough, ragged or feather edges; that defendant's Exhibit No. 2 is the same as the original excelsior produced and that there is no difference in the appearance in the edges between the excelsior produced on his machines and that produced on Antonson's "tearing machine." It is true this witness was discredited. It came about in this way. At the time the depositions were taken in Seattle he produced some excelsior which he testified was produced very early. Examination of the excelsior revealed dates much later than the time he claimed for manufacture, obviously showing that he was mistaken. Rafter explained this error by stating that through inadvertence he had picked up the wrong bundle of excelsior in the confused state of his then operating plant in Seattle. Rafter was then a man well along in years; he had lost his visual accommodation and could not see clearly at near distances without the aid of glasses. This is common to most people passing middle age; it is common knowledge that the crystalline lenses lose their accommodation. At the time of trial, having found the old excelsior, he voluntarily appeared before the trial court and produced the same, which is in evidence. (See Defendant's Exhibit EE.) There can be no question concerning the age of this excelsior. Its age authenticates itself; it is yellow and faded. Age alone will produce the physical characteristics patently visible in this exhibit.

C. A. WHEELER.

This witness lived in Seattle in 1923. He came in contact with the Rafter machine in about December of that year, and as above pointed out, purchased a machine of Rafter, shipped it to Portland, used it in Portland, and sold it to C. C. Hedrick, which is the very machine involved in this litigation. He testified he observed the machine and its product very carefully; that the edges of the paper excelsior were rough, such as torn paper always has (R-193).

E. L. FOSTER.

This witness was in Seattle in 1923 and 1924. He purchased a machine from Rafter in 1924 and moved it to Boston, Massachusetts, where he operated it for a short time and later sold the same to Antonsen. In the record this machine is spoken of as the "Foster" machine. The record shows that the witness knew Antonsen or companies in which Antonsen was associated (R-321). The record further shows that this witness made a statement prior to the taking of his deposition in which he definitely stated that the excelsior was rough edged. He stated that the edges were due to the fact that the process tore rather than cut newspapers, especially when folded newspapers were run through the machine. When his deposition was taken he varied from his original statement. Your attention is invited to the record (R-321 to 332). Repudiating in his part his previous written statement, the witness testified,—sometimes the excelsior was torn and sometimes it was not

torn, the former result obtaining if four or more sheets were fed through, and if less, the latter (R-322).

The appellee also produced witnesses showing the character of the excelsior produced by Wheeler when he first came to Portland.

KENNETH W. HOLMAN.

This witness at the time involved and now is a resident of Portland, Oregon, manager of Edward Holman & Son, Morticians. He testified the mentioned firm first used paper excelsior, as he best recalled, in 1925, purchasing the same from Wheeler and that this excelsior had a rough, irregular edge. He remembered discussing it with their employees and as to how it might have been made. (R-180).

L. V. SCOTT.

At the time involved and now this witness was and is a resident of Portland, Oregon, engaged in business as a wholesale paper merchant of many years' standing. He first came in contact with paper excelsior when he met Wheeler some time between 1923 and 1925. He made a very careful examination of the excelsior. He testified the excelsior was about one-fourth of an inch in width, with ragged or irregular edges; further, that defendant's Exhibit "J" is a fair sample of the excelsior he observed back in 1924, which, of course, was produced by Wheeler on the now claimed infringing Rafter machine (R-191).

C. C. HEDRICK, Appellee.

This party was and is a resident of Portland, Oregon, and purchased the machine in question from Wheeler in about March, 1929,—then started to operate the same and has been operating ever since. He testified that the machine at the time of his first inspection, produced rough edged excelsior, indicating production by a tearing process.

Your attention is invited to Part 9 of Appellant's Brief, Page 34, headed, "**Early Users of Excelsior.**" You will note he comments only on the testimony of one witness. The testimony of all the other witnesses, without comment, is brushed aside. A reading of the record as above referred to, will clearly show this court why the appellant attempted such a strategical retreat from this accumulated testimony. Claude E. Rafter, it is true, was impeached and so was Foster, but the other witnesses, as shown by the record, were men of standing and integrity.

The appellee did not rest his case on this oral testimony, though unquestionably he could have done so with safety. He produced physical evidence. Attention is called to the old excelsior produced by Claude C. Rafter at the time of trial (Defendant's Exhibit EE).

Shortly before and at the time of trial Wheeler discovered old excelsior which he had placed in the interstices of the building where he first operated his machine on coming to Portland. Samples of this old excelsior were placed in evidence. (See Defend-

ant's Exhibits Q and E). Even the appellant admits this is very old. Appellant has sought to impeach the testimony of Wheeler. Wheeler testified that he remembered placing the excelsior in the interstices as early as the winter of 1924. The record does not show that all the excelsior placed by Wheeler between interstices, were placed at one time, nor is such a conclusion of fair inference from the record (R-194 and 197). Antonsen, and others, during the course of trial, searched Wheeler's old factory and found additional specimens of old excelsior. These specimens were made of news print paper and it was shown that some of the paper had not been printed until June 13, 1925. Argument was then made that none of the excelsior could have been placed in the interstices in the winter of 1924 and that Wheeler was mistaken. The argument, while legitimate, is, in our judgment, unsound, and even though it be sound, we point out, as pointed out by the court in its opinion, that this excelsior is very old.

Again, the defendant produced prints of certain photographs taken by a Seattle paper on or about March, 1925. These prints are identified as "Defendant's Exhibits M and N." The machine shown in these prints is the old Rafter machine, which, at the time the picture was taken, was being operated by Antonsen. According to the contention of Antonsen, this machine at this time, as well as all prior times, was producing smooth edged excelsior, as though cut by scissors. The prints disclose strands

of excelsior with rough, ragged edges. This excelsior was examined by Vernon Faxon, an expert on questionable documents and instruments. He examined these prints for the appellee. He found some edges with torn or rough appearance (R-182). He explained that some of the edges could not be defined because the picture was taken out of exact focus. These prints were examined under a microscope in court. Various of these ragged edges are marked on the mentioned prints. One has but to look to see that they were ragged and jagged and not clean cut.

Against this array of testimony the appellant produced only two witnesses—himself and Mrs. Wright, whose close relation to Antonsen has been previously noted. She testified that the Rafter machine cut a very smooth edged excelsior,—“same as with scissors.” (R-333). Antonsen likewise testified.

Antonsen maintained that the Rafter machine made straight edged excelsior; that there was a very decided distinction between the excelsior produced on the Rafter machine and that later produced on his “tearing machine.” Antonsen purchased and operated, in an unchanged condition, a Rafter machine for approximately one and a half years. He had that machine in continuous operation in the city of Seattle and sold that excelsior to various customers in that city. We ask this court these simple questions:

1. Why did not Antonsen produce an operator of the Rafter machine when it was being operated by

him, to testify that he produced cut edged excelsior?

2. Why did not Antonsen produce a single user of excelsior who would tell the court that there was a difference between the excelsior produced on the Rafter machine and that produced on the Antonsen machine?

3. How does Antonsen account for the fact that he failed, though he claims he appreciated the vast difference between the excelsior produced on the Rafter machine and on his "tearing machine," to keep or find a single sample so as to evidence this difference? If the difference claimed by Antonsen did in fact exist between the excelsior produced on the Rafter machine and that produced on his tearing machine, namely, that the former was smooth edged and the latter rough edged, in all the city of Seattle, among his friends and customers, the inventor could have found at least a single witness who would so testify on the witness stand. What a man fails to do is even more indicative of the true state of affairs, than what he does.

As pointed out in appellant's brief, prior to and at the date Rafter built his machine, there was in existence a machine for cutting paper excelsior known as the Blumfeld-Rapp machine. At the time Antonsen purchased the Rafter machine in June, 1924, he knew of the existence of this other machine. (See defendant's Exhibit Y and R-84.) Antonsen now contends that the Rafter machine did the very thing that the Blumfeld-Rapp machine did. We submit that the

evidence very overwhelmingly, clearly and convincingly shows, as was found by the trial court, that from the moment power was applied to the Rafter machine it produced torn excelsior.

REVIEW OF EVIDENCE SUPPORTING FINDING THAT RAFTER'S MACHINE WAS ADJUSTED SO THAT THE INTERMESHING DISCS WERE SEPARATED.

Many witnesses testified that from the beginning the discs on the Rafter machine were not in facial contact but separated from one-thirty-second to one-sixteenth of an inch.

CLAUDE C. RAFTER.

Rafter testified the intermeshing discs were not in surface contact but spaced approximately $1/32$ nd of an inch (R-285); that the discs were so spaced on the machine Antonsen bought in June, 1924 (R-286). He further testified that if the discs were in surface contact so they ran metal to metal, they would have lasted about a day. Givenan, expert for appellee, corroborated this latter statement (R-223).

CLAUDE E. RAFTER.

The Court will recall that this witness was associated with Antonsen for several months after Antonsen's purchase of the Rafter machine and during such period actually operated the machine. He testified the discs were separated; that there was a

spring on the top rolls which tended to keep the discs together but did not; it only prevented the discs from separating too far apart when a lot of paper was put through at one time (R-305).

THOMAS E. HENDERSON.

Henderson, a man of some mechanical skill, co-purchaser of a Rafter machine, stated there was separation between the discs (R-299).

C. A. WHEELER.

Wheeler critically examined the Rafter machine in December, 1923 or January, 1924 and observed that the discs were separated about 1/16th of an inch. The court knows that Wheeler purchased a Rafter machine (which is the identical machine involved in this litigation), and originally the discs were not in facial contact but were separated a distance varying from 1/32nd to 1/16th of an inch (R-196). And when appellee purchased this particular machine the discs were likewise separated (R-200). As pointed out in appellant's brief, appellee took testimony to show that the discs never heated, smoked, showed excessive wear, or needed oiling (see also Antonsen's testimony, R-81.) Appellant claims production of such testimony was due to adroitness. We deem it a reflection of common sense. If the discs ran in facial contact, let alone forced facial contact, they would have worn out in a very short time (R-223). Even a layman knows what happens when metals, such as were in the discs, run in surface con-

tact at the rate of speed the discs were operating. It is perfectly obvious from the record that it was easy to adjust the Rafter machine so as to have the discs separated. The Rafter machine was constructed so that the discs did not necessarily have to be placed in surface contact, and it was a very simple matter to adjust the machine so as to effect separation. We will not review all the testimony on these points, as we deem them conceded of record by appellant's own experts, McDougall and Rockwell.

QUESTIONS BY MR. FENLASON:

“Q. Now, in the original Rafter machine—say the Foster machine which was built by Rafter—could a shoulder be placed so as to prevent the spring from bringing the shredding discs into facial contact to assure, when not spread by cutting or shredding paper, that the discs be returned to a positive point and that they would be in a close contiguous relation?”

A. So they would be in close condition but not touching?

Q. Yes.

A. Yes, obviously.

Q. In other words, the construction was not such that necessarily they would have to be in contiguous facial contact?

A. No. That would not be absolutely necessary. That was the arrangement, however, in the machine that I observed.” (Testimony of Rockwell, R-126, 127.)

“Q. Now, didn't you state, when I asked you about the shifting of the lower roll that it had a

nut there that could be used for that purpose?

A. Oh, it has a nut there, yes, sir.

Q. You don't claim that that nut has been added, do you?

A. No, that nut was not intended for that purpose.

Q. But could it have been used for that purpose, sir?

A. If the manufacturer knew that that purpose was desirable, it could have been used for that purpose.

Q. And then would it have read upon this claim?

A. If used for that purpose it would read on that claim, yes, sir.

Q. So that you had everything present in the machine by screwing a nut to give a spaced relationship?

A. You had everything present except the knowledge of how to do it which is taught in the Antonsen patent and the utility derived therefrom." (Testimony of McDougall, R-170, 171.)

Antonsen testified:

"In experimenting with my third machine one day I had it to pieces. In putting it together, I left off a nut and when I fed paper through it the machine broke. The next day I put it together, didn't adjust it, ran the paper through it and I noticed it went faster than ever." (R-76.)

Obviously Antonsen's alleged invention had a queer birth.

Clearly, it was a very simple matter to effect a separation. This acknowledged fact forcefully corroborates the testimony of the witnesses that separation was practiced. Every one of the above witnesses had full and ample opportunity to make, and did make, critical examinations of the actual adjustment of the Rafter machine. To refute this testimony, the appellant offers his testimony and that of two witnesses, Foster and Rockwell, and also, strongly relies upon Rafter's file wrapper.

Rockwell testified, when he examined the Foster-Rafter machine in July, 1925 (the machine then being owned by Antonsen and located in his Seattle plant) that the discs were in contact. Admittedly during Rockwell's examination this machine was merely turned over by hand. Rockwell, of course, did not undertake to state that this machine was in the same condition as originally constructed by Rafter. Obviously, it was just as easy to bring the discs in contact as it was to put them out of contact, which, after all, was simplicity itself. In other words, it was a very easy matter for Antonsen, or anyone else so desiring, to fix the machine so that the discs were in contact. Rockwell's evidence, accordingly, is of little value. Antonsen testified that the discs were in contact.

Much has been said in appellant's brief to create the impression in the court's mind that appellant's witnesses intentionally or unintentionally, but one way or the other, more or less fabricated their tes-

timony. It should be constantly borne in mind that Antonsen is the one who would greatly profit if he could sustain his patent. The door of easy wealth would open wide if he can convince the court that his patent is valid. In this case every motive which might be urged to discredit the testimony of any of appellee's witnesses is doubly present with respect to Antonsen and his witnesses.

Foster testified that the discs were in facial contact. We have already called the court's attention as to how this witness varied his statements. In his original statement this witness stated: "In the front there was a nut on the end of one of the shafts so that the knives could be spaced in a position to tear rather than cleanly cut paper" (R-326). The use of this nut was well understood.

We point out again that Antonsen did not call a single one of his operators who operated his Rafter machine, to testify that the discs were touching and not separated. Is not the reason apparent? Great stress is placed upon the Rafter file wrapper. It is claimed that this silent witness shows that Rafter and all the other witnesses were mistaken. It will be recalled that Rafter's patent attorney never personally inspected the machine (R-311). The evidence is overwhelmingly clear and convincing that in actual practice the discs were not adjusted in facial contact but were separated. We agree with the trial court (R-33) that this point is no particular value since all the evidence shows that under cer-

tain circumstances the machine constructed by Rafter did operate while these discs did not have the cutting edges in contact. We reviewed the evidence merely to show this court that the findings of the trial court in the particular under discussion is well justified by the evidence.

REVIEW OF EVIDENCE SUPPORTING FINDING THAT IT WAS AN INHERENT INCIDENT AND QUALITY OF THE RAFTER MACHINE THAT UNDER LOAD A SEPARATION WOULD TAKE PLACE BETWEEN THE ADJACENT INTERMESHING DISCS.

In its opinion (R-33) the court stated, and in its findings found that from the very beginning when a few sheets of paper stock were fed into the Rafter machine a separation occurred between the edged sides of adjacent intermeshing discs and that this was a natural incident and quality of the machine. (See Finding 5, R-46-47.) The record conclusively necessitates and justifies the statement and finding. What actually happened is well described by Claude E. Rafter:

“When we first started out we put through just a little at a time, thinking the excelsior would look nicer, but when we got to selling a little more we started crowding the machine and it cut a rougher edge on the paper. The edge was what you would term, I suppose, a feather edge or a scallop edge, or anything that is rough. The paper when being discharged

from the machine would just fall out and fly all over. There was no way of keeping it straight. It would get all bunched up and mixed up in a haphazard fashion and this condition existed from the very beginning. Each knife had a spacer between it. There was a spring on the top roll that tended to keep these knives together but it didn't do it. It kept the knives from spreading too far when we put through a lot of paper at one time. The discs on the bottom roll have a tendency to spread when you run through multiple thicknesses of paper. The more you put through the more would tear instead of cut, really. All the machines that were built were the same. I can't see any difference in them. I met Mr. Antonsen when he bought my father's business and then I went to work for Mr. Antonsen after he bought my father out. I started with Antonsen in June, 1924, and remained with him until March, 1925. At that time Antonsen was using my father's machine to make excelsior." (R-304, 305.)

All witnesses testified that when the machine was in actual operation, separation took place: C. C. Rafter (R-285 and 301); Henderson (R-301); Foster (R-322).

Appellant's experts, Rockwell and McDougall, conceded that the separation would take place but opinionated that any separation would stop the machine. Antonsen stated that any separation caused the machine to stop (R-82). Rockwell admitted that the number of sheets required to cause a separation would depend upon the strength and tension of the

coil spring (R-100). When pressed, he further admitted if the machine did not stop, torn excelsior would be produced (R-101, 102). These experts compared the separation taking place with reference to the sides of adjacent intermeshing discs as comparable to the springing of the blades of shears. Separation in the Rafter machine was not induced by springing the discs but by a compresison of the top spindle spring which necessitated a uniform movement of all the effected discs. In shears the blades are firmly fixed at their butt ends,—such is not true as respects the discs. It should be remembered that these experts were present with the court, the parties to this action, and their attorneys, when by mutual agreement the court inspected appellee's Rafter machine and watched it in actual operation and otherwise. On cross-examination Rockwell, in effect, admitted that he saw and heard the very thing take place which he previously testified in his opinion was impossible (R-112-113).

The trial court said in its opinion:

“The experts for plaintiff testified that the Rafter machine could not produce torn excelsior for the reason that it would jamb as soon as it failed to cut the paper. The court rejects this conclusion in the fact of the direct evidence that it did not jamb under such circumstances and the direct evidence drawn from the actual operation of the defendant's machine.” (R-33.)

We wish this court were permitted to make a

physical examination of the machine in question. If you were so privileged we venture the assertion that your language towards the experts would not be as tolerant as that of the trial judge. The evidence necessitated the findings made by the trial court.

Appellant contends that discs in facial contact produce straight-edged cut excelsior and that rough-edged excelsior is produced when discs are out of contact. We have pointed out the evidence which shows, as clearly we believe, as it is humanly possible to produce evidence to show, that the paper excelsior produced by the Rafter machine from the very time motor power was applied was rough-edge excelsior. This very fact itself corroborates the testimony that the sides of adjacent intermeshing discs were not touching; it authenticates this fact. All the evidence for the appellee dovetails together in a pattern of truth and well it should, for it is the truth.

ANTONSEN'S EARLY RELATIONS WITH RAFTER AND THE RAFTER MACHINE.

A clear understanding of Antonsen's early relations with Mr. Rafter and his machine is desirable so that the background of this litigation may be seen in its true perspective. We have previously pointed out that Antonsen learned of the Rafter machine and its products as early as January, 1924, a short time after Rafter began production operation. An-

Antonsen claims that he was working on a paper machine of his own at this time. The record shows nothing but his own word to support this statement. Antonsen viewed with awed astonishment this new machine. Remember away back in 1924 Antonsen knew of the Bloomfelt-Rapp cutting machine. Yet when he first saw Rafter's machine he immediately visioned that Rafter had created a new industry and also saw that Rafter failed to appreciate the commercial value of that which he had done. Thomas E. Henderson was present when Antonsen viewed Rafter's machine early in 1924. Let Henderson tell the story:

“About March 1, 1924, I had a conversation with Antonsen, when he said, ‘This is a wonderful thing, isn’t it?’ ‘You are going to San Francisco?’ ‘Well, you have got the best town on the Coast. Rafter has got a mint and don’t know it’.” (R-299.)

Antonsen does not deny that he made this statement. Immediately Antonsen sought to and did buy Rafter's machine. This machine had cost Rafter about \$100.00 to build. Antonsen got in addition a few miscellaneous articles of personal property of little value and such business as Rafter had established. For this he paid, admittedly, \$2900.00. It seems incredible that Antonsen, familiar with the paper business, already learned in the art of cutting paper (as he states) would have paid \$2900.00 for a machine making cut paper excelsior when the physi-

cal property he aquired had a total value not to exceed \$350.00. Antonsen was shrewd enough to know a good thing when he saw it. He appreciated its commercial value to the extent that he was willing to pay a handsome price and with that same degree of shrewdness he has sought and now seeks to gain for himself the monopolistic rights throughout the United States of the very thing he purchased in 1924. The trial court saw Antonsen on the stand, heard his story, heard the depositions read, heard the witnesses; it is not surprising the trial court said:

“Antonsen’s actions are entirely convincing to the court if other proof were lacking.” (R-36.)

For more than a year Antonsen operated the purchased Rafter machine. We take it that he had no trouble in disposing of the paper excelsior. We find no complaint in the record. In about a year’s time he claims to have made an invention. The invention, so far as the claims in question are concerned, consisted of separating the sides of the adjacent intermeshing discs. This alleged invention was born of mistake, not of conception. Then Antonsen set about getting it patented and finally secured the patent here involved. He bought up the Foster machine. He tried to buy the appellee’s machine. He brought law-suits in districts removed from the early development of the Rafter machine and finally he brought this suit. Antonsen claims the Rafter machine caused much trouble in actual operation; that

its capacity was limited to a few sheets; that his machine clearly increased the capacity and eliminated choking. The Rafter machine did not give the trouble Antonsen would have you believe. The trouble claims are exaggerated. We invite you to inspect the testimony of the following witnesses:

“I could cut quite a pile if everything went all right.” (Wright, R-335.)

“I didn’t have any particular trouble with the machine clogging.” (Foster, R-323.)

“Maybe she would choke once a day; maybe she would not choke for a week after that.” (Henderson, R-300.)

“It did not clog a great deal; I never had no trouble with it.” (Claude C. Rafter, R-313.)

“The machine did clog on some occasions. That is when I fed more than twenty-four thicknesses, then the thing stopped dead. If there were any foreign substances in the paper, it would also make the machine stick.” (Wheeler, R-195.)

Antonsen claims his machine greatly increased the capacity. We doubt if there was any great increase. Unquestionably the old Rafter machine had a practical capacity.

“You could feed about twenty pages of newspaper through. That would be 10 sheets.” (Claude C. Rafter, 3-313.)

“We used to take a twelve page paper like you have here. You couldn’t cut the Sunday Times with it. You couldn’t cut that. It was too heavy.” (Henderson, R-299.)

“I found by experimenting twenty-four thicknesses was about as much as could be fed without slowing the machine.” (Wheeler, R-194.)

Of course the capacity of the Rafter-Henderson machine when it came into the possession of appellee, was and has remained the same. (See Hedrick, R-201.)

Antonsen claims that he could shred sixty pages with his machine. Sixty pages equals thirty sheets. Taking Antonsen’s testimony at its face value, his machine has an increased capacity but building a machine more sturdily and stronger is not invention.

NOVELTY CLAIMED BY ANTONSEN WITH RESPECT TO CLAIMS 1, 2 and 7.

We now desire to examine claims 1, 2 and 7 to ascertain what novelty is claimed by Antonsen as to each of these claims. Appellant’s experts contended that separation of the side edges of the adjacent intermeshing discs was novelty with respects to claims 1 and 2 (McDougall, R-155); and that “the description torn” is novel in claim 7 (McDougall, R-158). Obviously, if the Rafter machine produced torn excelsior from 1923, this claimed novelty with respect to claim 7 is eliminated; and equally obviously, if in 1923 or at any time two years prior to appellant’s application for letters patent, the side edges of the adjacent intermeshing discs were in a space rela-

tionship (separated), the novelty claimed with respect to claims 1 and 2 is eliminated. Unquestionably, the Rafter machine in 1923 and on down to date made paper excelsior out of sheets of paper stock by severing the same into narrow strips, separating these strips more or less and discharging and piling them in a haphazard fashion: See Claude C. Rafter (R-282); Henderson (R-299); Simpson (R-308); Wheeler (R-192); Mrs. Wright, witness for appellant:

“It piled up in a sort of haphazard pile on the floor.” (R-333.)

See defendant’s exhibits M and N.

We believe we have conclusively shown that the Rafter machine made torn excelsior and had separations between the side edges of adjacent intermeshing discs. Novelty, as claimed, does not exist. The review of testimony clearly shows the Court’s findings are fully justified with respect to the Rafter machine making torn excelsior and having separation.

Furthermore, we submit appellant cannot claim “separation” in claims 1 and 2 and “tearing” in claim 7, as the novelty of these claims. His claims for the same were denied by the Examiner:

See Antonsen file wrapper, plaintiff’s exhibit 13.

See particularly pages 13, 14, 17, 18, 21 and 22.

The above mentioned elements were old in the

art of record. The applicable law is so well known and settled as to require no particular citations of authorities. See, however:

Knapp vs. Morss, 150 U. S. 221; 37 L. Ed. 1059.

Rogers on Patents, Vol. 2, page 853.

Hopkins on Patents, Vol. 1, pages 188, 189; see also page 416.

AS TO ADMITTED INFRINGEMENT OF APPELLANT'S PATENT.

The pleadings do admit that the process inherent in appellee's machine reads upon Claim 7 of the involved patent, but appellee does not admit the machine reads upon Claim 1. Givenan, expert for the appellee, testified that appellee's machine did not read on Claims 1 and 2 (R-206). Appellee's machine has no self-contained means for bodily shifting the discs on the lower spindle for the purpose of adjusting their space relation with the discs on the upper spindle. You will note that means for bodily shifting the discs of either group in the axial direction of their spindles for the purpose of adjusting their space relationship with the discs of the other group is the outstanding element of Claim 1. We have noted that the appellant's expert, McDougall, testified claims 2 and 1 are the same thing—a re-statement in different language. We do not deem this a matter of importance, because of the defenses. The above is pointed out so that this court may have before it the state of the record.

AS TO ALLEGED CHANGES IN RAFTER- WHEELER-APPELLEE MACHINE.

The appellant claims the above identified machine has been changed. Appellant's experts do not undertake to testify just how this change has been effected although they were given full opportunity to examine the machine before and during the trial. As far as the questions involved in this lawsuit are concerned, the slight changes made by Wheeler have no bearing. Wheeler put on a fly wheel in place of the nut (R-194). His purpose was to balance a pulley (R-195). He also fastened longitudinal strips on the front of the machine for the purpose of forming a rest. He used this rest as a fulcrum for the tool used to clear the paper from the discs when they became filled (R-194). He did not change the discs or the spreaders (R-194). Obviously these changes had absolutely nothing to do with the mechanical functioning of the machine or its inherent qualities and attributes. As far as the appellee is concerned, no changes were made (R-203). Rafter did not construct these machines with great care and precision. Obviously, as pointed out by the court in its opinion, complete facial contact or a uniform amount of separation between the side edges of the adjacent intermeshing discs could not have been accomplished except by the most careful workmanship and absolute precision machine work. (R-32; R-210, and see also just preceding testimony.)

THE LAW

Undoubtedly Rafter is the "father" of commercially used paper excelsior. The product met with favor when first introduced in 1923 and has continued that favor ever since. A new business was born,—not of temporary life,—but of enduring quality.

Appellant, on page 36 of his brief by Part 10, headed, "Effective Date of Patent," cites authority to show that Antonsen's alleged patent relates back to the date of his alleged disclosure to Rockwell in February, 1925. We are not here concerned with the question of interference which sometimes arises in the prosecution of an application for letters patent. We are here concerned with well known statutory defenses. These defenses are so familiar and well known as to need no particular citation of authority.

With respect to the defense of novelty because of prior public use, we point out that a single sale is sufficient evidence of prior use.

Consolidated Fruit Jar Co. vs. Wright, 94 U. S. 92; 24 L. Ed. 68.

Egbert vs. Lippman, 104 U. S. 333; 26 L. Ed. 755.

Hall vs. McNeale, 107 U. S. 90; 27 L. Ed. 367.

Indeed, prior use of articles as samples will suffice to establish this defense.

Dalby vs. Lynes, 64 Fed. 376.

While ordinarily this defense must be established by proof beyond a reasonable doubt, still the character of the proof will largely depend upon the nature of the thing sought to be anticipated.

“It requires less testimony to establish a fact which was very likely to have occurred than to establish an improbable theory.”

Shipman, Judge, in *Lee vs. Upson & Hart Co.*, 43 Fed. 670, 671. See also *Hopkins on Patents*, 1911 Ed., Vol. 1, Page 422.

Walker on Patents, Par. 116, Note 96.

Prior use may be established by the oral testimony of unimpeached and disinterested witnesses even though the device itself has passed out of existence.

American Roll Paper Co. vs. Weston, 59 Fed. Rep. 147, 150; 8 C.C.A. 56.

And in rare circumstances by the testimony of a single witness.

National Casket Co. vs. Stolts, 157 Fed. 392, 393, 85 C.C.A. 300.

Considering the oral testimony, the courts, of course, will look to see whether the particular machine is complicated and by reason thereof unskilled persons might be led into error in their recollections.

Rochester Coach Lace Co. vs. Schaefer, 46 Fed. Rep. 190, 193.

The involved machine is about as simple a machine as you can find in commercial life. Appellee's

evidence meets every requirement of the law. It establishes every fact found by the trial court as certain as any fact, concerning which there is a conflict of testimony, can be established.

The case of *Atlantic Works vs. Brady* (a leading case), 107 U. S. 192, 27 L. Ed. 438, is very much in point. It is about as near on "all fours" with the present case as one patent case can be said to be on all fours with another. The Supreme Court held:

"The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the art. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith."

This doctrine has been repeatedly followed in a great number of cases, to-wit:

Slawson vs. Grand St. R. Co., 107 U. S. 649; S. C. 2 Sup. Ct. Rep. 663; in King vs. Gallun, 109 U. S. 99; S. C. Sup. Ct. Rep. 85; in Double-pointed Tack Co. vs. Two Rivers Manuf'g Co., 109 U. S. 117; S. C. 3 Sup. Ct. Rep. 105; in Estey vs. Burdett, 109 U. S. 633; S. C. 3 Sup. Ct. Rep. 531; in Bussey vs. Excelsior Manuf'g Co., 110 U. S. 131; S. C. 4 Sup. Ct. Rep. 38; in Pennsylvania R. Co. vs. Locomotive etc. Truck Co., 110 U. S. 490; S. C. 4 Sup. Ct. Rep. 220; in Phillips vs. City of Detroit, 111 U. S. 604; S. C. 4 Sup. Ct. Rep. 580; in Morris vs. McMillin, 112 U. S. 244; S. C. 5 Sup. Ct. Rep. 218; and in Hollister vs. Benedict & Burnham Manuf'g Co., 113 U. S. 59; S. C. 5 Sup. Ct. Rep. 717.

The Supreme Court further said:

“But if a different conclusion could be reached, to our minds, it is as certain as any fact depending on conflicting testimony can be, that Brady derived the ideas embraced in his patent from Gen. McAlester, the government officer, who in 1867 had charge of the improvement at the mouth of the Mississippi river, and that he never conceived these ideas till they were communicated and explained to him by Gen. McAlester during the fitting up of the Wiggins Ferry at New Orleans, and during the progress of her operations in the Southwest pass.”

The only perceivable difference between the Brady case and the case at bar is that Brady got

his idea from General McAlester for nothing while Antonsen got his from Rafter and Rafter's machine, paying a substantial sum for the same.

The fact that Antonsen may have increased the efficiency of the machine does not entitle him to a patent.

Hollister vs. Benedict & Burnham Mfg. Co.,
113 U. S. 59.

And which there exists no hard and fast rule to determine or which defines "invention," a valid invention may fairly be said

"* * to spring from that intuitive faculty of the mind put forth in the search for new results, or new methods, creating what had not before existed or bringing to light what lay hidden from vision. * * *" Hollister case, *supra*.

We have pointed out that by Antonsen's own testimony, his alleged invention arose from maladjustment. The trial court pointed out in its opinion that Antonsen stabilized the discs in the position which they attained in the Rafter machine when operating at a high speed and overcrowded (R-35). This certainly did not amount to invention. As pointed out by the court it was a mere mechanical operation. The Supreme Court said in the *Brady* case, *supra*:

"The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head-work

men and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequences."

The mere exercise of mechanical skill is not invention.

See Hopkins on Patents, 1911 Ed., page 226 and cases cited in footnotes 257 and 258.

"It is not invention to merely improve upon workmanship; to make solid parts previously made separable; to make separate parts previously made integral; to merely change the relative location of parts without changing the function performed; to omit a part or parts with a corresponding omission of function."

Rogers on Patents, Vol. 1, Page 12.

CONCLUSION

As far as appellant was concerned, there was no novelty in the machine produced by him of which the public had not already had the advantage; he is not entitled to monopolize the advantage already the property of the public. The Trial Court person-

ally heard the testimony in this case, considered it very carefully and his findings and conclusions are fully warranted by the evidence. The decree should be affirmed.

Respectfully submitted,

C. O. FENLASON,

Solicitor for Appellee.

